

03500.017853



PATENT APPLICATION

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
	:	Examiner: H. Tran
KEIICHIRO ISHIHARA)	
	:	Group Art Unit: 2861
Application No.: 10/763,231)	
	:	
Filed: January 26, 2004)	
	:	
For: MULTI-BEAM SCANNING)	
APPARATUS	:	July 27, 2006

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION TO WITHDRAW REQUIREMENT
FOR ELECTION BETWEEN SPECIES

Sir:

This is a Petition under 37 C.F.R. § 1.144, seeking withdrawal of the requirement for election between species as entered in the Office Action dated March 20, 2006, and as made final in the Office Action dated June 26, 2006.

It is not believed that a Petition fee is needed. However, if a Petition fee is needed, then the Petition fee should be charged to Deposit Account 06-1205.

A request for reconsideration of the Examiner's requirement for election was filed on April 20, 2006. See 37 C.F.R. § 1.143. Accordingly, this Petition is timely. Pursuant to MPEP § 1002.02(c), the Petition is being directed to the Director of Technology Center 2800.

FACTS

1. In the first Official Action in the application, dated March 20, 2006, the Examiner imposed a seven-way requirement to elect between allegedly distinct species. However, in contravention of the procedure at MPEP § 806.04, the Office Action did not identify any specifically different embodiments that were described in the specification. Rather, relying on the language of the independent claims, the Office Action “manufactured” different embodiments.

2. In a Response filed April 20, 2006, a provisional election was made, with traverse. In keeping with correct application of requirements for election between species, the election was made with respect to the first embodiment of the invention, which is a scanning apparatus illustrated in Figures 1 through 6, and to such a scanning apparatus as incorporated into an image forming apparatus of Figures 19 and 20. In keeping with the description on page 31 of the first embodiment of the invention, which explains that a light source unit can include three or more radiation points, the USPTO was advised that the claims that read on the elected species of Figures 1 through 6 (and Figures 9 and 20) were as follows: Claims 1 to 10, 20 to 34 and 42 to 56.

3. A traversal of the requirement was also entered. Traversal was on the grounds that the Office Action did not establish any of the factual predicates needed to impose a requirement to elect between species, for the reason that the Office Action did not identify any specifically different embodiments that were described in the specification. It was demonstrated that the Office Action relied on claim language of the independent

claims to “manufacture” allegedly different embodiments, and in particular it was pointed out that page 5 of the Office Action inadvertently included the claim number (claim 51) as part of the definition of the species. It was further explained that this procedure, where allegedly different embodiments were “manufactured” from claim language, was contrary to clear USPTO practice on this point. In particular, a quotation was provided from MPEP § 806.04(e) in support of the Applicant’s position that it is non-sensical to rely on claim language to define specifically different embodiments:

"Claims are definitions of inventions. Claims are never species. Claims may be restricted to a single disclosed embodiment (i.e., a single species, and thus be designated a specific species claim), or a claim may include two or more of the disclosed embodiments within the breadth and scope of definition (and thus be designated a generic or genus claim).

"Species are always the specifically different embodiments."
(Emphasis in original.)

4. Traversal was also based on burden, for the reason that the specification describes only seven different embodiments such that burden could not be established consistent with Applicant’s prerogative to present a “reasonable number” of species. See 37 C.F.R. § 1.141(a).

5. The USPTO’s response was contained in the Office Action dated June 26, 2006. In this response, the Office Action maintained that the USPTO’s reliance on claim language was correct and that the claims themselves could provide specifically different embodiments that were described in the specification:

“[T]raversal is on the ground(s) that ...the Office Action did not identify the specifically different embodiments described in the specification. This is not found persuasive because the original claims are

part of the disclosure. As such the claims can be used to impose a requirement to elect between species.” (Office Action dated June 26, 2006, page 2.)

6. The Office Action also maintained its position that there would be burden, relying on MPEP § 808.02. Overlooking the fact that § 808.02 applies to restriction requirements, and not to requirements for elections between species, the Office Action changed the wording of MPEP § 808.02 so as to replace the word “invention” (as correctly used at MPEP § 808.02) with “species” or “embodiments”:

“This is not found persuasive because different search queries used in searching for the distinct species indicate different fields of search, even though the different embodiments are classified together.”
(Office Action dated June 26, 2006, at page 2.)

7. As a consequence, the Office Action indicated that the requirement for election between species was made “final”.

8. In addition, the Office Action refused to examine all of the claims identified by the Applicant as reading upon the elected species. Rather, without further explanation as to why the Examiner believed that they did not read on the elected species, the Examiner refused to consider elected Claims 4 to 10, 28 to 34, 42, 43 and 49 to 56. Instead, the Examiner agreed to consider only Claims 1 to 3, 20 to 27 and 44 to 48. All remaining claims were withdrawn from further consideration.

9. Of Claims 1 to 3, 20 to 27 and 44 to 48, which were all the claims considered by the Examiner, all claims were allowed.

ARGUMENT

10. MPEP is clear on the relationship between claims and species: there is none. As explained at MPEP § 806.04(e), quoted above, it is possible for a claim to be limited to a single disclosed embodiment, or to include two or more disclosed embodiments within its breadth and scope. For this reason, it makes no reason to equate claims with species.

11. Nevertheless, and in spite of the arguments presented in its traversal, the Examiner maintained his requirement to elect between species that were “manufactured” from claim language. In particular, the following chart is offered to show how claim language was used to manufacture species that were alleged to be distinct:

Species i	Independent Claims 1 and 25
Species ii	Independent Claims 4 and 28
Species iii	Independent Claims 11 and 35
Species iv	Independent Claims 18 and 42
Species v	Independent Claim 49
Species vi	Independent Claims 50 and 52
Species vii	Independent Claim 51

12. Indeed, in making the requirement for election “final”, the Examiner openly conceded that he had relied on claim language to manufacture species, and did not

contend that his so-called species were in any way related to the embodiments that were actually disclosed in the specification.

13. Accordingly, the requirement to elect between species was based on a faulty factual predicate, since the Office Action did not identify any of the specifically different embodiments that were described in the specification. The requirement to elect between species should therefore be withdrawn for this reason alone.

14. Moreover, in its attempt to justify burden, it was incorrect for the Office Action to rely on MPEP § 808.02, since that section applies to requirements for restriction and not to elections between species. Rather, Applicants maintain the position that burden cannot be established in the present situation where they are presenting a “reasonable number” of different embodiments (here, seven different embodiments), as they have a right to do.

15. Finally, no reason was given for refusing to examine all claims identified as reading on the elected embodiment of Figures 1 through 6 (and Figures 19 and 20 insofar as the elected scanning apparatus is incorporated into an image forming apparatus of those figures). Roughly speaking, the claims can be categorized into pairs, in which a first one of the pairs is directed to “plural radiation points” and the second one of the pairs is directed to “at least three radiation points”:

Plural radiation points

Claim 1

Claim 4

Claim 11

Claim 18

Claim 49

Claim 50

At least three radiation points

Claim 25

Claim 28

Claim 35

Claim 42

Claim 51

Claim 52

15. In their election with traverse, the Applicants explained that page 31 of the specification disclosed an arrangement in which the light source unit of the first embodiment could include three or more radiation points. For this reason, the Applicants advised the Examiner that the claims that read on the elected species were Claims 1 to 10, 20 to 34 and 42 to 56. However, in continued reliance on his “manufactured species”, the Examiner refused to consider claims 4 to 10, 28 to 34, 42, 43 and 49 to 56. This action was improper. Should the requirement for election be maintained or reformulated, Applicants respectfully submit that they are entitled to examination of all claims that read on their elected first embodiment.

CONCLUSION

WHEREFORE Applicants respectfully Petition for a withdrawal of the requirement to elect between species. In the alternative, should the requirement for

election be maintained or reformulated, Applicants respectfully Petition for an examination on the merits of all of Claims 1 to 10, 20 to 34 and 42 to 56, which read on their elected first embodiment.

Applicant's undersigned attorney may be reached in our Costa Mesa, California office at (714) 540-8700. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Frank L. Cire', written over a horizontal line.

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